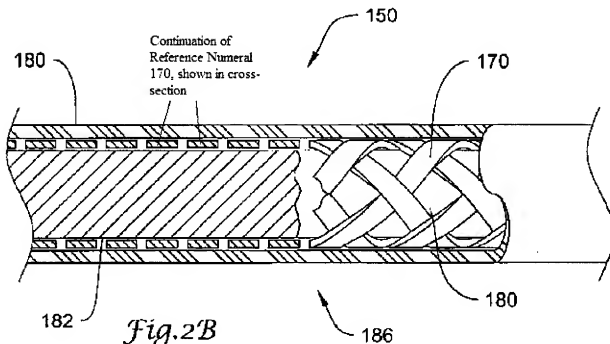


## **REMARKS**

Applicant has carefully reviewed the Office Action of November 21, 2008, prior to preparing this response. Claims 19-22, 24-26, 28-35, 37, and 38 are pending and have been rejected. With this paper, claims 19, 28, and 37 have been amended. Support for the amendments may be found in the specification, claims and drawings as filed. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

### **Drawings**

The drawings have been objected to under 37 CFR 1.83(a). The Examiner asserts the overlap between the braid and the tubular shaft must be shown or the feature canceled from the claims. Applicant respectfully asserts the overlap is shown in Figure 2B. In order to facilitate the discussion, Figure 2B has been reproduced below.



As can be seen, the ribbon braid 170 is shown disposed over the tubular shaft 182. One of ordinary skill in the art would recognize that in order for the braid to be disposed over a portion of the tubular shaft 182 and extend distally therefrom, the braid would be disposed over the distal

end of the tubular shaft. Reconsideration and withdrawal of the objection are respectfully requested.

**Claim Rejections Under 35 U.S.C. §112**

Claims 19-22, 24-26, 28-35 and 37-38 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses the rejection. The Examiner asserts, "Claims 19, 28, and 37 contain the phrase 'wherein the braid overlaps the distal end of the tubular shaft'." The specification at page 5 merely describes the relation of the braid and the tubular shaft as attached at the junction. There is no mention of whether the braid lays over or under the tubular shaft." As can be seen in the reproduction of Figure 2B above, the braid is clearly shown as disposed over the tubular shaft 182. One of ordinary skill in the art would recognize that in order for the braid to be disposed over a portion of the tubular shaft 182 and extend distally therefrom, the braid would be disposed over the distal end of the tubular shaft. Reconsideration and withdrawal of the rejection are respectfully requested.

**Claim Rejections under 35 U.S.C. §§102 and 103**

Claims 19-22, 24, 26, 28-33, 35, 37 and 38 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Lundquist, U.S. Patent No. 5,228,441. Applicant respectfully traverses this rejection.

Independent claim 19 recites in part, "the braid is disposed over the distal end of the tubular shaft such that a portion of the braid is located proximal of the distal end of the tubular shaft." Independent claims 28 and 37 recite similar limitations. Lundquist does not teach or suggest a device wherein the braid is disposed over the distal end of the tubular shaft and thus cannot be considered as anticipating the claimed invention. In formulating the rejection, the Examiner asserts, "Under the definition 'to lie or extend over and cover part of', the above claims are found to be obvious over Lundquist, as it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the braid to overlies the tubular member, since it has been held that rearranging parts of an invention involves only routine skill in the art."

Lundquist teaches a torque tube 31 and a braided tubular member 54. The braided tubular member 54 is disposed underneath and/or within the torque tube. As shown in Figure 3 of Lundquist, both elements have a uniform outer diameter and a uniform inner diameter, with the exception of some slots 41 in torque tube 31. Torque tubes, in particular, are known to have a generally uniform outer diameter. This is significant to the discussion in light of another feature of the device of Lundquist. The outermost diameter of the device is defined by shrink tubing 46, the final dimensions of which are determined by the outer diameter of torque tube 31. Therefore, if one inverts the torque tube 31 and the braided member 54, putting braided element 54 over torque tube 31, it appears the maximum outer diameter of the device would increase. The outer diameter of these sort of intravascular devices is critical as the outer diameter is the dimension which limits what lumens the device can fit into. Increasing the outer diameter without any countervailing advantage being introduced produces a device that is less satisfactory for its intended purpose. Insofar as it may not be able to fit where it otherwise could have fit without the design change, the proposed modification may indeed render the prior art device unsatisfactory for its intended purpose. MPEP 2143.01 V states, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Therefore, for at least the reasons set forth above, Lundquist does not teach or suggest each and every element of independent claims 19, 28, or 37. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Lundquist to arrive the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. For similar reasons and others, Applicant submits that claims 20-22, 24, 26, 29-33, 35, and 38 are also in condition for allowance as they depend from one of claims 19, 28 and 37 and add significant limitations to further distinguish them from the prior art.

### **Claim Rejections under 35 U.S.C. §103**

Claims 25 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lundquist, U.S. Patent No. 5,228,441, in view of Schwartz et al., U.S. Patent No. 5,437,288. Applicant respectfully traverses this rejection.

Claim 25 depends from claim 19 and claim 34 depends from claim 28. For at least the reasons stated above, Lundquist fails to teach each and every limitation of claims 19 and 28. The teachings of Schwartz et al. fail to remedy the shortcomings of Lundquist. Thus, even if one were to combine Lundquist and Schwartz et al., one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Lundquist and/or Schwartz et al. to achieve the device as claimed.

Therefore, because claims 19 and 28 are believed to be in condition for allowance, Applicant submits that claims 25 and 34, which depend from claims 19 and 28, respectively and add further limitations, are believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

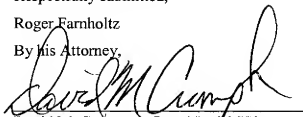
**Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Roger Farnholtz

By his Attorney,



David M. Crompton, Reg. No. 76,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: \_\_\_\_\_

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